

No. 71-485

AUG 8 1972

MICHAEL RODAK, JR., C

In the Supreme Court of the United States

OCTOBER TERM, 1971

ROBERT GOTTSCHALK, Commissioner of Patents,
Petitioner,

vs.

GARY R. BENSON and ARTHUR C. TABBOT,
Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE CHICAGO BAR ASSOCIATION AS AMICUS CURIAE

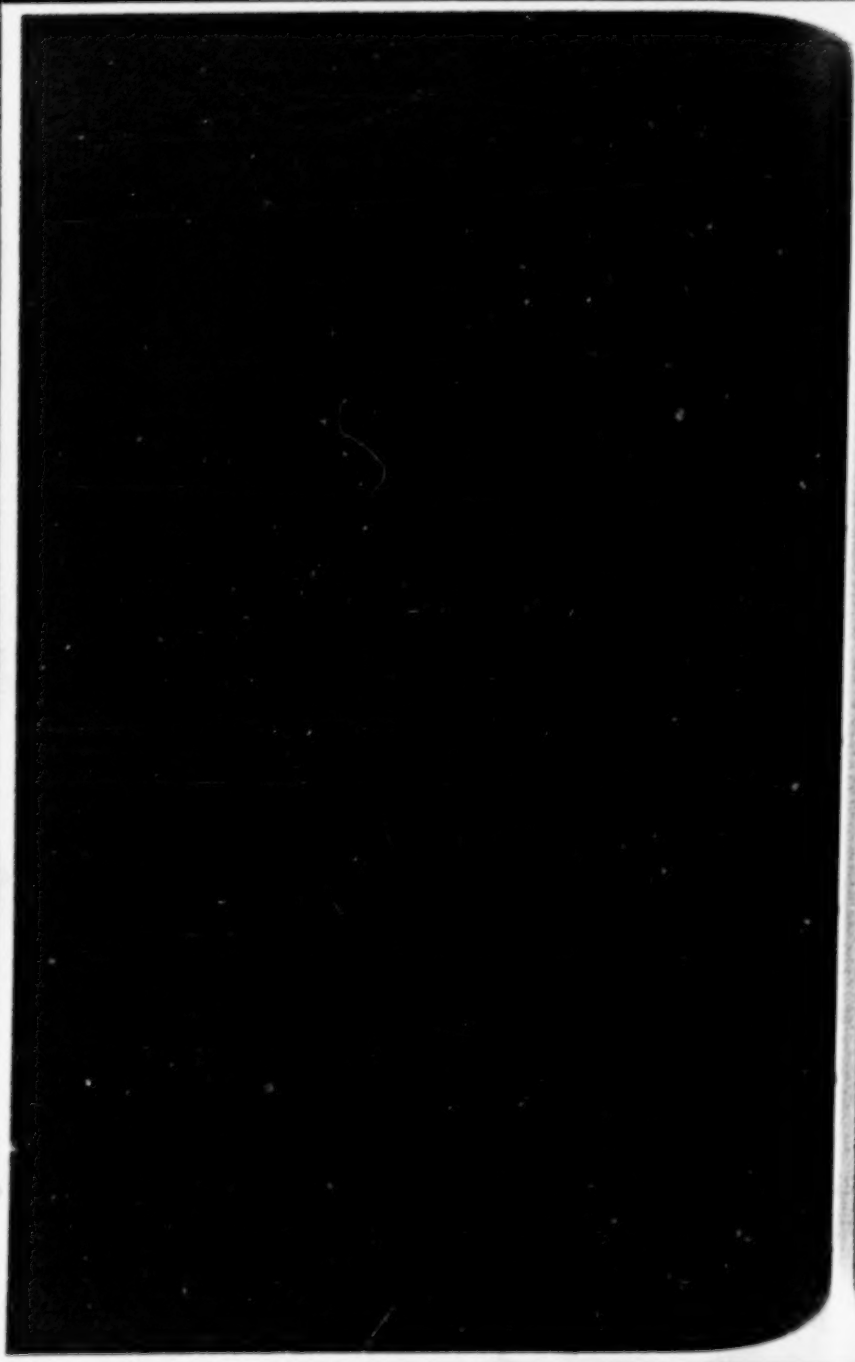
CLARON N. WHITE
111 West Washington Street
Chicago, Illinois 60602

LOUIS ROBERTSON
P.O. Box 670
Arlington Heights, Illinois 60006
Attorneys for Amicus Curiae
The Chicago Bar Association

Of Counsel:
BERNARD L. KLEINKE
33 North Dearborn Street
Chicago, Illinois 60602

JOHN R. DIVER
7 South Dearborn Street
Chicago, Illinois 60603

MANNING K. LEITER
33 North Dearborn Street
Chicago, Illinois 60602



In the Supreme Court of the United States

OCTOBER TERM, 1971

No. 71-485

ROBERT GOTTSCHALK, Commissioner of Patents,
Petitioner,

vs.

GARY R. BENSON and ARTHUR C. TABBOT,
Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE CHICAGO BAR ASSOCIATION AS AMICUS CURIAE

Authority to File

This Brief as *amicus curiae* in support of respondent is filed pursuant to Rule 42-2 of the Supreme Court. The letters of consent from the Petitioner and the Respondent are on file with the Clerk of the Court.

Interest of The Chicago Bar Association

The Chicago Bar Association is an association of members of the Bar of the State of Illinois and either residing, practicing law or both in the Chicago area. The membership includes more than 10,000 lawyers of which about 400 are lawyers specializing in the law of patents, trademarks, copyright, or other closely related fields of the law. This brief is being filed on behalf of The Chicago Bar Association and was prepared and approved by its Patents, Trademarks and Trade Practices Committee after authorization of its Board of Managers. The Committee represents that the issues here involved concern the public interest and the Court is respectfully urged not to render any decision which would tend to remove the field of computer programming from the incentives for progress afforded by the patent system.

ARGUMENT

I. THE COURT SHOULD NOT LEGISLATE REMOVAL OF ONE CLASS OF PATENTABLE PROCESSES FROM THE PATENT SYSTEM MERELY BECAUSE OF ALLEGED PATENT OFFICE DIFFICULTIES.

This brief is especially opposed to contention II of the Appellant's argument reading:

> "II. Patentability of computer programming methods would tend to undermine the present patent system because the claims in this area can not be adequately classified and searched."

The mere statement of this contention seems to tacitly concede that there is nothing in the patent statute to exclude patenting a program which is a new and unobvious* process for operating a general purpose computer. It asks this Court to judicially legislate that area of invention out of the patent system solely on the basis of the stated policy considerations.

Even if the premises suggested were true, this would not so much be a reason for excluding the area from the patent system as for improving the ability of the Patent Office to operate in that area. If the Patent Office expertise and search facilities are less in this area than in others (which this brief does not concede) this deficiency would be reduced rapidly by increased experience alone as the Patent Office is forced to begin more normal and complete operations in the area.

---

*No question of obviousness is believed properly before the court.

If it be assumed that possibly the Patent Office could never reach a level of operations as satisfactory as in other areas, this would surely be a matter for consideration by the Congress, with hearings for exploring the degree of present deficiency, the danger of its continuation and what remedies are available. Congress would have remedies not available to the Court. An example would be a statute requiring publication of an invention for citation of prior art by anyone interested, with Patent Office review before such patent could be enforced. Even such a statute preferably should not single out computer programs for this treatment, because if desirable at all it would be desirable in *any instance* in which the Patent Office regarded its facilities as unusually deficient.

II. THE COURT SHOULD NOT REVERSE THE CCPA ON MERE NICETIES OF CLAIM DRAFTING.

As to the Appellant's Argument I* this brief notes agreement with the general principle that a claim should not be allowed which covers *merely* a mental process. It is perhaps unimportant to the public interest whether the present claims are held to distinguish sufficiently from a *mere* mental process (as by reference to "registers") so long as the Court makes clear (if it finds the present language not acceptable) that *some* language more clearly requiring a process of operation of a computer machine must be accepted. Because there is doubt this court should even concern itself with the niceties of how well a claim distinguishes from a *mere* mental process, we urge affirmance of the decision of the CCPA.

---

* "I. The claimed process is unpatentable because it is no more than a set of mental steps for carrying out mathematical procedures."

The inclusion of Argument II in the Appellant's brief suggests that the Patent Office may in its Argument I have been trying a little too hard to find ways to refuse patents in this area.

CONCLUSION

The judgment of the Court of Customs and Patent Appeals should be affirmed.

Respectfully submitted,

CLARON N. WHITE
111 West Washington Street
Chicago, Illinois 60602

LOUIS ROBERTSON
P. O. Box 670
Arlington Heights, Illinois 60006
Attorneys for Amicus Curiae
The Chicago Bar Association

Of Counsel:
BERNARD L. KLEINKE
33 North Dearborn Street
Chicago, Illinois 60602

JOHN R. DIVER
7 South Dearborn Street
Chicago, Illinois 60603

MANNING K. LEITER
33 North Dearborn Street
Chicago, Illinois 60602